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IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. 543

JIFFY LUBRICATOR COMPANY, INC.,
Plaintiff-Petitioner,

vs.

THE ALEMITE COMPANY,
Defendant-Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

FOREWORD.

The petition for writ of certiorari and the brief filed in support thereof when stripped of their prolixity, constitute nothing more than an attack upon the appellate court's exercise of its familiar and long established power to direct the entry of a judgment notwithstanding the verdict of a jury where the undisputed facts leave no issue for determination by the jury.

In this case the Court of Appeals on the undisputed facts held the patent in suit clearly invalid and directed the entry of a judgment of dismissal. Such action of the Court of Appeals in directing the entry of a judgment of dismissal is in accord with the practice under the common

law approved by this Court in *Baltimore and Carolina* v. *Redman,* (295 U. S. 654).

This approved common law appellate practice of entering or directing judgment upon reversal has more recently been incorporated into the Judicial Code (28 U. S. C. § 2106) relative to which this Court stated on January 16, 1950:

> "Under this statute for the first time the power of the Supreme Court and the Courts of Appeals to enter judgment when remanding a case to the lower court is set out in identical language in a single section. That coextensive power is to direct 'such appropriate judgment * * * as may be just under the circumstances.' * * *" (*Bryan* v. *United States,* ..... U. S. ..... 94 Law Ed. Adv. Op. 287, 290.)

A SHORT STATEMENT OF THE CASE.

Petitioner's failure to set forth "a summary and short statement of the matter involved" in this cause compels Respondent to make that statement in this Brief.

This is an ordinary patent infringement suit involving the usual issues of validity and infringement. The District Court overruled respondent's motions for a directed verdict and for judgment notwithstanding the verdict (I R. 57) and entered judgment for petitioner (I R. 61). The Court of Appeals reversed on the ground that the patent was clearly invalid for lack of invention (176 F. 2d 444, VIII R. 2246). In so doing the Court of Appeals acted in accordance with 28 U. S. C. § 2106 and in accordance with long-established and well-recognized Federal procedure.

The Johnson patent No. 2,040,177 here in suit has never been passed upon by any Court other than the Courts which have acted in the instant suit although there is now pending another suit on the patent in another circuit. There is no conflict of decisions nor is there involved any general principle of law which is of public interest and which would justify this Court in devoting its time and effort to consideration of this controversy between private parties.

The Device of the Patent in Suit and the Accused Devices Are Lubricating Couplers of the Chuck Type in Which the Lubricant Pressure Secures the Coupler to the Lubricant-Receiving Nipple.

Johnson patent No. 2,040,177, which is here in suit, was issued May 12, 1936 (IV R. 1348), and is entitled "Hydraulic Lubricating Connection." This patent covers

generally a coupler for connecting a grease gun to a grease fitting or nipple for the purpose of lubricating a bearing of an automobile or other piece of machinery to which the fitting or nipple is attached. The particular form of gripping means utilized in the Johnson patent for securing the coupler to the grease fitting or nipple is of the chuck type, wherein jaws are moved forwardly into a tapering sleeve to constrict or force the jaws against the fitting, in the same manner in which the jaws of carpenter's braces and drills are urged into gripping engagement with bits and drill shanks.

At the time the Johnsons made, in 1930, the first coupler of the kind shown in the patent in suit, most automobiles and many other machines had their bearings equipped with the cylindrical fittings of Gullborg patent No. 1,307,734 (IV R. 1545). Such fittings had an inlet end provided with a passage yieldably closed by a ball which rested on a spring supported by a cross pin that extended transversely through the cylindrical fitting and projected from both sides thereof. The coupler of the Gullborg patent had a piston-like sealing member for engaging the flat end of the fitting and a cylindrical shell provided with bayonet or L-shaped slots which would engage and lock with the ends of the pin when the coupler shell was slipped over the cylindrical fitting and rotated with respect thereto.

The coupler of the Johnson patent in suit was designed for attachment to the Gullborg fitting by gripping the cylindrical end of the fitting beyond the pin. The Johnsons' purpose in substituting a chuck type of gripping means for the bayonet slots of the Gullborg coupler was to seek to avoid a holding that this chuck-type coupler was an infringement of the Gullborg patent and not to produce a coupler of superior merit. This was alluded to in the decision of the Court of Appeals (176 F. 2d 446; VIII R. 2240).

The Alemite hydraulic couplers which are charged to be infringements of the Johnson patent are different from the structure shown in the patent in design, construction, and mode of operation. These couplers, which are shown in the blueprints, Defendant's Exhibit 95 (IV R. 1434-69), were designed for use with a headed fitting and are not capable of use with the Gullborg fitting. The Alemite hydraulic couplers form a ball and socket joint with the head of the fitting to which they are attached and have metal sealing surfaces engaging the fitting to prevent leakage of lubricant therebetween when the coupler is located either in direct alignment with the fitting or at a substantial angle with respect thereto.

The Art in Which the Patent in Suit Appeared Was an Old and Well-Litigated Art in Which Courts Had Defined Established Limits of Potential Invention.

Throughout the years many patents have issued on various forms of couplers for attaching a grease gun to a grease fitting or nipple associated with a bearing to be lubricated. In *Bassick Mfg. Co.* v. *Hollingshead Co.* (298 U. S. 415), this Court in 1935 had occasion to consider one of these patents—Gullborg patent No. 1,307,734 issued on June 24, 1919 (IV R. 1545). This Court stated the Gullborg patent related to

> "• • • an improvement in the hose coupler, which is but one element in the old and well-understood combination of a compression chamber or pump, a hose, a hose coupler, and a grease cup or fitting connected to the bearing to be lubricated • • •." (298 U. S. 415, 419.)

In *Lincoln Engineering Co.* v. *Stewart-Warner* (303 U. S. 545), this Court in 1938 had occasion to consider Butler patent No. 1,593,791 dated July 27, 1926 (V R. 1705)

which disclosed a coupler for connecting a grease gun to a fitting and in which were used the principles inherent in the old carpenter's braces and drill chucks. Of this Butler patent for a chuck-type coupler this Court stated:

> "* * * Butler's alleged invention is in the same field and deals with similar apparatus as did Gullborg's patent, considered in the Rogers (Hollingshead) case. As there shown, it was old practice in the lubrication of bearings to use in combination a fitting connected with the bearing through which oil or grease was to be propelled into the bearing and a gun, which was joined to the fitting by a coupler. In the greasing operation the coupler is fastened to the head of the fitting and the pump is operated to drive the lubricant through the fitting to the bearing. Not only was this combination old but the elements long used in the art varied in design and dimension. Fittings were of different sizes and shapes and had diverse arrangements for their closure when not in actual use for the injection of lubricant. Guns were of many sizes and types. Various forms of coupler had been used for sealing the connection between the pump hose and the fitting. * * * (303 U. S. 545, 546, 547.)
>
> "* * * The invention, if any, which Butler made was an improvement in what he styles in his specifications the 'chuck' and in his claim a 'coupling member.' It is not denied that multi-jawed chucks had been used in industry and as couplers in lubricating apparatus. **Butler may have devised a patentable improvement in such a chuck in the respect that the multiple jaws in his device are closed over the nipple by the pressure of the grease, but we think he did no more than this.** * * * The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention. * * *" (303 U. S. 545, 549.) (Emphasis ours.)

The asserted invention of the Johnson patent in suit, made many years after the Butler patent issued, was merely a variant of the Butler chuck with multiple jaws closing over the nipple by the pressure of the grease. This is readily apparent from the chart attached to the back cover of this brief reproducing figures from the prior art in this Record,* all of which disclose the simple arrangement of a fluid operated chuck of this type, in which the fluid pressure wedges the jaws in the chuck against an encircled connector to secure the connection.

Prior to the opinion of the Court of Appeals in this case the same Court in 1939 considered the Boker patent No. 1,802,700 dated April 28, 1931,—another patent covering a lubricating coupler. In holding the Boker patent invalid the Eighth Circuit Court of Appeals stated (*Min-A-Max Co.* v. *Sundholm*, 102 F. 2d 187, 188):

> "* * * The nozzles through which the lubricant is forced from grease pumps into standard grease cup equipment either fit over and fasten to the grease cups or are manually held thrust into them or against them. It seems likely that many of the thousands of handy mechanics in these United States could readily make suitable nozzles for the purpose. * * *"

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* The Saxton drawing which appears as No. 12 on this chart is taken from a Saxton patent application (D. Ex. EE, V. R. 1727) filed prior to the Johnson application and involved in a Patent Office interference with the Johnson application. In this interference both the Patent Office Examiner and Board of Appeals held Saxton, and not the Johnsons, to be the first inventor and the Johnson application was finally rejected. The Johnson patent was issued only because Saxton failed to complete the prosecution of his application and failed to take out his patent. Whether the Patent Office had the power to issue the Johnson patent, after the Patent Office had determined Saxton to be the first inventor, is one of the issues which was raised in the Court of Appeals but not there decided.

In the Trial Court Respondent Repeatedly Raised the Issue Determined by the Court of Appeals—That the Patent in Suit Was Clearly Invalid.

Undoubtedly these earlier decisions delineating the narrowing area in which Petitioner had to assert invention induced Petitioner to request a jury. At the conclusion of the trial Respondent moved for a directed verdict under Rule 50 of the Federal Rules of Civil Procedure (I R. 51). In its motion for a directed verdict Respondent asserted that the Johnson patent was invalid because clearly anticipated, **was invalid for lack of invention over the prior art,** and that upon all of the evidence it appeared that **no cause of action had been established as to the issues of either validity or infringement** (I R. 51-3). The case was submitted to the jury which returned a verdict for Petitioner.

Respondent moved to set aside the verdict of the jury and to have judgment entered in accordance with its motion for a directed verdict and again asserted (I R. 54) that **the verdict could not be sustained as there was no substantial evidence on the material issues sufficient to justify or support** it, that the Johnson patent was invalid because anticipated **and for lack of invention over the prior art,** and that upon all of the evidence and as a matter of law it appeared **that no cause of action had been established either as to the issues of validity or infringement** (I R. 54-7). The trial court without opinion denied Respondent's motion for judgment notwithstanding the verdict (I R. 57). Respondent appealed to the Court of Appeals and assigned as one of the points relied on that:

> "* * * the claims in suit of the Johnson and Johnson patent are invalid because these claims are anticipated by **and are invalid for want of invention over the prior art patents and commercial structures**

introduced in evidence and because the patentees of the patent in suit were not the original and first inventors of any material and substantial part of the alleged invention disclosed and claimed in these claims. * * *" (I R. 76) (Emphasis ours.)

The Court of Appeals (176 F. 2d 444) (VIII R. 2236) reversed the judgment of the trial court for the reason that the Johnson patent **was clearly invalid for lack of patentable invention.** Notwithstanding Petitioner's repeated assertions that the Court of Appeals reversed on patents not relied upon by Respondent and on points not asserted by Respondent, the record clearly discloses that Respondent in its pleadings, in its motion for directed verdict, in its motion for judgment notwithstanding the verdict, and in its appeal, consistently urged that the Johnson patent was clearly invalid for lack of invention. In its opinion the Court of Appeals stated:

> "* * * The defendant denied infringement, denied that the Johnsons were the first inventors of the coupler disclosed by the patent in suit, **and asserted that the patent was void because of anticipation and lack of invention.**" (VIII R. 2237) (Emphasis ours.)

There is no foundation for Petitioner's statement that the Court of Appeals reversed the judgment of the trial court on grounds not asserted by Respondent.

ARGUMENT.

I.

THERE BEING NO CONFLICT OF DECISIONS NOR IMPORTANT QUESTION OF FEDERAL LAW PRESENT, THERE IS NO REASON FOR THE GRANT OF THE PETITION.

This Court has repeatedly stated that an ordinary patent infringement case does not present any important questions of Federal law worthy of consideration by this Court. As stated in *Keller* v. *Adams-Campbell Co.* (264 U. S. 314, 319):

> "* * * Such an ordinary patent case with the usual issues of invention, breadth of claims, and noninfringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent. * * *"

In *Layne and Bowler Corp.* v. *Western Well Works Co.* (261 U. S. 387, 393), this Court stated:

> "* * * it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal."

See also *General Talking Pictures Corp.* v. *Western Electric Co.* (304 U. S. 175, 178, 179).

This absence of any real issue which would justify this Court in issuing a writ of certiorari is made abundantly clear by the laborious, involved, and lengthy Petition for Writ of Certiorari and Brief in support thereof which have been filed by Petitioner. If Petitioner had a single

worth-while issue to present to this Court, the Petition could have disclosed it. Petitioner has created a number of fictional issues which are not present in the case.

What the Petition seeks by indirection to attack is the propriety of the exercise by the Court of Appeals of the long established and familiar power to reverse a judgment based upon a verdict of a jury when the undisputed facts establish such clear invalidity of the patent in suit that no question was presented by the evidence for resolution by the jury.

Petitioner conceals this attack in such extravagant assertions as that the Court of Appeals for the Eighth Circuit was not aware of the rule that a patent is prima facie valid. There is absolutely nothing in the clear opinion of the Court of Appeals which even suggests that the experienced Judges of the Court of Appeals were unaware of this elementary rule of patent litigation. Petitioner's counsel overlooked no opportunity to stress the rule vehemently and often.

This presumption of validity, like any other similar presumption, may be overcome by evidence. In the instant case the Court of Appeals expressly pointed out that in view of all of the evidence the patent was clearly invalid, and it therefore had no occasion to refer to the presumption of validity which had been wholly overcome by such evidence.

II.

THE COURT OF APPEALS PROPERLY REVERSED THE JUDGMENT OF THE TRIAL COURT ON THE GROUND THAT THE PATENT BEING CLEARLY INVALID THERE WAS NO QUESTION TO BE SUBMITTED TO THE JURY FOR DETERMINATION.

The structure of the chuck-type lubricating coupler shown and described in the Johnson patent is exceedingly simple. The prior art patents introduced in evidence contain drawings and complete descriptions of the method of operation of the respective structures shown in the drawings. The physical devices introduced in evidence may be readily inspected and their mode of operation and construction readily appear on such inspection. There was no disputed question of fact relative to the operation of the structures shown in the Johnson patent and the prior art. The claims of the Johnson patent can be readily applied to the prior art.

The undisputed facts established by the record in this case abundantly confirm Respondent's contention throughout the trial and on appeal that there was no question properly to be submitted to the jury.

In *Market Street Cable R. Co.* v. *Rowley* (155 U. S. 621, 625), this Court stated:

> "Did the court below err in refusing to instruct the jury to find a verdict for the defendant on the ground that the patent sued on was void for want of novelty?
>
> "The defendant put in evidence a number of patents prior in date to the plaintiff's, and asked the court to compare the inventions and devices therein described with those claimed by the plaintiff. No extrinsic evidence was given or needed to explain terms of art, or to apply the descriptions to the subject-matter, so that the court was able, from mere comparison, to

say what was the invention described in each, and to affirm from such mere comparison whether the inventions were or were not the same. The question was, then, one of pure construction and not of evidence, and consequently was matter of law for the court, without any auxiliary fact to be passed upon by the jury.

"If upon the state of the art as shown to exist by the prior patents, and upon a comparison of the older devices with those described in the patent in suit, it should appear that the patented claims are not novel, it becomes the duty of the court to so instruct the jury.

* * * * *

"In view then, of the state of the art as manifested by several prior patents, we think it is plain that the patent of Lyon and Munro is void for want of patentable novelty, and that the court below erred in not so instructing the jury." (id. 630.)

The Court below, in its opinion in the instant case, stated (176 F. 2d 444, 445; VIII R. 2238):

> "The vital question for decision is, we think, whether the patent in suit (referred to as the Johnson patent) is clearly invalid for lack of patentable invention over the prior art. If the patent is clearly void, the verdict of the jury is, of course, of no help to the plaintiff and other questions need not be considered."

The principle applied by the Court, that in situations such as presented by the record in this case, where there is no fact to be passed upon by the jury, the verdict of a jury is of no help, is completely confirmed by the following patent cases:

Hurin v. *Electric Vacuum Cleaner Co.* (C. C. A. 6, 298 Fed. 76, 78).

McIlvaine Patent Corp. v. *Walgreen Co.* (C. C. A. 7, 138 F. 2d 177).

Ryan Distributing Corp. v. *Caley* (C. C. A. 3, 147 F. 2d 138).

Burroughs Adding Mach. Co. v. *Rockford Milling Mach. Co.* (C. C. A. 7, 292 Fed. 550).
Delories v. *Whitney* (C. C. A. 1, 63 Fed. 611, 618).
Brothers v. *Lidgerwood Mfg. Co.* (C. C. A. 2, 223 Fed. 359, 360).

An analysis of the opinion of the Court below discloses that the Court of Appeals considered not only the undisputed art of record in this case, but also:

(a) the opinion of this Court in the *Hollingshead* case (298 U. S. 415) in which the Gullborg patent relating to a manually operated grease coupler was held invalid;

(b) the opinion of this Court in the *Lincoln* case (303 U. S. 545) in which the Butler patent, relating to an automatic chuck-type grease coupler which rendered the older manual type coupler automatic by the incorporation therein of the principles of the old and generally used multi-jawed chucks, was considered and held invalid;

(c) its opinion in *Stewart-Warner* v. *Jiffy* (81 F. 2d 786), also dealing with the Butler patent, in which the Court stated:

> "Reviewing the prior art, however, we find that it is an old idea to make a chuck whose jaws or gripping elements are segments carried by a cylinder; the segments being drawn together into firm grip upon an object by wedging action between the cylinder and the segments. It is also an old idea to actuate the segments so carried in a cylinder into gripping by wedging action caused by the forward movement of a piston in the cylinder." (81 F. 2d 786, 791.)
>
> "* * * Though none of these patents actually anticipates the claim of the Butler patent covering his coupler adapted for lubricating apparatus, they preclude any conclusion that his was a pioneer patent in the art of making automatic chucks. * * *" (81 F. 2d 786, 792).

(d) its opinion in the case of *Min-A-Max* v. *Sundholm* (102 F. 2d 187), in which the Boker patent on a lubricating coupler was held invalid and in which the Court stated in 1939:

> "* * * It seems likely that many of the thousands of handy mechanics in these United States could readily make suitable nozzles for the purpose. * * *"

Considering the reason for making the alleged invention of the Johnson patent in suit the Court of Appeals below in its opinion in this case stated:

> "* * * It appears that August Johnson told an automobile mechanic in or about 1928 about making something to do away with the old type of connector so that he (Johnson) would not have to use the pin on the Alemite fitting, and that he thought he could make something that would work like a drill chuck, utilizing the force from the grease gun to grip the fitting during the greasing operation. The mechanic understood what Johnson was talking about, and thought it would work." (176 F. 2d 444, 446; VIII R. 2240-1.)

The Court of Appeals thus accepted the patentee's own testimony (V R. 1894-2004) relative to the structure and purpose of the lubricating coupler of his patent and upon the authority of the earlier opinions, stated:

> "* * * Substituting an old and well known form of coupler for another form of coupler equally well known, did not, in our opinion, require invention, but merely mechanical skill.
>
> "* * * To use means old in the art to clamp a grease nozzle to a grease fitting so as to form a tight connection, does not involve patentable invention. * * *" (176 F. 2d 448.)

* * * * *

"Since it is our opinion that the evidence, viewed in the aspect most favorable to the plaintiff, does not

sustain the conclusion that the Johnsons' contribution to the art of lubrication rose to the level of patentable invention, it is unnecessary to consider other questions." (id. 449.)

In other words, the Court of Appeals held that any slight changes in shape and substitution of old elements to which plaintiff could point in support of the Johnson patent did not amount to patentable invention. In this respect the Court of Appeals conformed to the views of this Court as expressed in *Jungersen* v. *Ostby & Barton Co.* (335 U. S. 560), wherein this Court said:

"* * * The patentee claims that the centrifugal forcing of wax into the primary mould had never before been combined with the other features of his process. We think this fact is of no legal significance. Where centrifugal force was common as a means of introducing molten metal into the secondary mould, its use in an intermediate step to force molten wax into the primary mould was not an exemplification of inventive genius such as is necessary to render the patent valid. Cf. *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545, 82 L. ed. 1008, 58 S. Ct. 662; *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 86 L. ed. 58, 62 S. Ct. 37. The patentee himself admitted that the same principle was employed in both steps. Thus Jungersen employed in his claimed invention well known skills and practices in a manner and for a purpose long familiar in the field of casting. His claimed improvement is therefore not patentable." (335 U. S. 560, 566, 567.)

Petitioner Is Really Attacking the Established Practice of Entry of Judgment by a Court Where the Undisputed Facts Disclose No Issue of Fact to Be Submitted to a Jury.

What is apparent through the complexities of Petitioner's statement of its case is the fact that the real attack of the Petition is upon the appellate court's exercise of its familiar and long-established power to enter a judgment notwithstanding the verdict of the jury where the undisputed facts leave no issue for determination by the jury.

It is elementary that trial by jury is accompanied by the power of the court to direct the verdict of the jury, or to enter judgment notwithstanding a verdict, if the undisputed facts leave no issue for the jury's determination.

> "• • • But it is well settled that where the trial judge is satisfied upon the evidence that the plaintiff is not entitled to recover, and that a verdict, if rendered for plaintiff, must be set aside, the court may instruct the jury to find for the defendant." (Citing cases.) *The C. A. Treat Mfg. Company* v. *The Standard Steel & Iron Company*, 157 U. S. 674, 675.
>
> "If, after the plaintiff's case had been closed, the court had directed a verdict for the defendant on the ground that the evidence, with all inferences that the jury could justifiably draw from it, was insufficient to support a verdict for the plaintiff, so that such a verdict, if returned, must be set aside, it would have followed a practice sanctioned by repeated decisions of this court. • • • *Baylis* v. *Travelers' Insurance Company*, 113 U. S. 316, 320.

It is similarly clear that if judgment is entered upon a jury's verdict, the appellate court can direct a judgment if the trial court has erroneously ruled upon a motion for directed verdict. While the exercise of this power was

for long trammeled by procedural niceties as to whether a proper reservation had been made in the trial court to invoke the exercise of this power on appeal, (*Slocum* v. *New York Life Ins. Co.*, 228 U. S. 364) Federal Rule 50 (b) has fully clarified the procedural detail. *Montgomery Ward & Co.* v. *Duncan*, 311 U. S. 243, 250.

This Court, in *Baltimore & Carolina Line* v. *Redman*, 295 U. S. 654, not only exercised this inherent power of an appellate court, but, upon the narrow issue of whether upon reversal judgment should be directed or the case remanded for a new trial when the appellate court's determination extinguished any basis for liability, held that judgment should be directed.

The case was an action for negligence and the jury found for the plaintiff, motions for directed verdict were denied, and judgment for plaintiff entered. On appeal the Second Circuit Court of Appeals divided on the question whether it should reverse on the ground of the insufficiency of the evidence to present an issue for the jury, but the majority did reverse and remanded for a new trial. The Court of Appeals held that it could not enter a final judgment of dismissal.

This Court sustained not only the propriety of the appellate practice of reversing a judgment entered upon a verdict of a jury where the undisputed facts left no foundation for liability, but the practice of entering final judgment in the appeals court without the ultimately futile remand, saying (pp. 659-661):

> "At common law there was a well established practice of reserving questions of law arising during trials by jury and of taking verdicts subject to the ultimate ruling on the questions reserved; and under this practice the reservation carried with it authority to make such ultimate disposition of the case as might be made essential by the ruling under the reservation, such as

non-suiting the plaintiff where he had obtained a verdict, entering a verdict or judgment for one party where the jury had given a verdict to the other, or making other essential adjustments.

"Fragmentary references to the origin and basis of the practice indicate that it came to be supported on the theory that it gave better opportunity for considered rulings, made new trials less frequent, and commanded such general approval that parties litigant assented to its application as a matter of course. But whatever may have been its origin or theoretical basis, it undoubtedly was well established when the Seventh Amendment was adopted, and therefore must be regarded as a part of the common-law rules to which resort must be had in testing and measuring the right of trial by jury as preserved and protected by that Amendment.

"This Court has distinctly recognized that a federal court may take a verdict subject to the opinion of the court on a question of law, and in one case where a verdict for the plaintiff was thus taken has reversed the judgment given on the verdict and directed a judgment for the defendant."

* * * * *

"In view of the common-law practice and the related state statute, we reach the conclusion that the judgment of reversal for the error in denying the motions should embody a direction for a judgment of dismissal on the merits, and not for a new trial. Such a judgment of dismissal will be the equivalent of a judgment for the defendant on a verdict directed in its favor."

In *National City Bank* v. *Oelbermann,* 298 U. S. 638 (1936), this Court in a *per curiam* opinion followed the practice approved in the *Redman* case.

This common law Federal appellate practice of entering and directing judgment upon a reversal has recently been codified in the revision of the United States Code. Title 28, section 2106 provides:

"The Supreme Court or any other court of appel-

late jurisdiction may affirm, modify, vacate, set aside or reverse any judgment, decree, or order of a court lawfully brought before it for review, and may remand the cause and direct the entry of such appropriate judgment, decree, or order, or require such further proceedings to be had as may be just under the circumstances."

This section of the Code has had the consideration of this Court in the case of *Bryan* v. *United States* (94 L. Ed. Adv. Op. 287) wherein this Court pointed out that under this new section of the Code a Court of Appeals certainly has power to direct "such appropriate judgment . . . as may be just under the circumstances."

The common law procedure, both of reviewing the judgment after jury trial and reversing without remand for the new trial on the ground that the undisputed facts left no issue for the jury has been consistently followed in the United States Courts:

New England Mutual Life Ins. Co. v. *Cohen*, 83 F. 2d 163, 166 (C. C. A. 2).

Sheehan v. *New York, N. H. & H. R. Co.*, 93 F. 2d, 442, 444 (C. C. A. 2).

Geo. D. Horning v. *McAleenan*, 149 F. 2d 561, 565 (C. C. A. 4).

Sun Life Assur. Co. v. *Maloney*, 132 F. 2d 388, 390 (C. C. A. 5).

Conn. Mut. Life Ins. Co. v. *Lanahan*, 113 F. 2d 935 (C. C. A. 6).

Brunet v. *S. S. Kresge Co.*, 115 F. 2d 713, 716 (C. C. A. 7).

Lowden v. *Bell*, 138 F. 2d 558, 560-561 (C. C. A. 8).

That this procedure was properly followed in this case appears to be conceded by Petitioner in its contention that the Court of Appeals had not held the patent in suit "in-

valid as a matter of law" and the implication that had the Court done so the procedure would be unassailable (Brief, p. 5). Petitioner admits that there are circumstances where the issue can be decided as a matter of law, saying (Brief, p. 11):

> "The only way in which the question of invention (which, as pointed out above, is fundamentally a question of fact) could be converted into a question of law in the case at bar was if the evidence so overwhelmingly showed lack of invention that reasonable men could **not** have differed;—in which case the trial judge should have granted the motions for directed verdict or the motion for judgment notwithstanding the verdict."

That this is such a case Petitioner admitted in the Court of Appeals where it said in its brief, page 99:

> "* * * The determination of whether or not such anticipation is present can in some cases be determined by a mere comparison of the patent-in-suit with the prior patents relied on so that, under some circumstances, the Court can conclude, as a matter of law, that there is clearly no 'anticipation.' The case at bar is such a case."

That Petitioner was right in conceding this case to be "such a case" readily appears from the facts.

The Exercise by the Court of Appeals of Its Power to Reverse the Judgment Entered by the Trial Court Raises No Constitutional Question.

Petitioner by its questions 4, 8, and 9 asserts that the action of the Court of Appeals in reversing the judgment of the trial court deprived petitioner of its right to a jury trial and that this action is in violation of the rights guaranteed to it by the Seventh Amendment to the Constitution. This same type of argument was asserted in the case of *Ryan Distributing Corp.* v. *Caley* (147 F. 2d 138, C. C.

A. 3, 1945; cert. den. 325 U. S. 859). The *Ryan* case was a suit for patent infringement tried to a jury. The jury returned a verdict in favor of the patent owner. The Court set aside the verdict of the jury and entered judgment holding the patent invalid. Relative to the argument on the right to a jury trial, the Court of Appeals said (147 F. 2d 138, 142):

> "Finally, defendant argues that, if the trial judge's ruling is sustained, it deprives every patentee of his right to a trial by jury on the question of invention as guaranteed by the 7th Amendment of the Constitution. On this the defendant cites *Slocum* v. *New York Life Ins. Co.*, 1913, 228 U. S. 364, 33 S. Ct. 523, 57 L. Ed. 879 Ann. Cas. 1914D, 1029, but fails to cite the qualifying decision in *Baltimore & Carolina Line, Inc.* v. *Redman*, 1935, 295 U. S. 654, 55 S. Ct. 890, 79 L. Ed. 1636 and Rule 50(b) of the Federal Rules of Civil Procedure. Rule 50(b) was designed to reserve the legal question involved where a motion for a directed verdict made at the close of all the evidence is denied. Such reservation was held sufficient to empower the judge to enter judgment notwithstanding the verdict even though he denied the motion for directed verdict prior to submission of the case to the jury. Rule 50(b) in terms makes the denial subject to later determination if the proper steps are taken. See discussion in 3 Moore's Federal Practice § 50.02 and 8 Cyclopedia of *Federal Procedure* [2d ed.] § 3497. See also *Montgomery Ward & Co.* v. *Duncan*, 1940, 311 U. S. 243, 61 S. Ct. 189, 85 L. Ed. 147. Defendant's contention in this respect is wholly without merit."

In *Montgomery Ward* v. *Duncan* (311 U. S. 243, 254, 1940), this Court affirmed the right of an appellate court to reverse the action of the trial court in refusing to enter judgment notwithstanding the verdict, stating:

> "• • • The appellate court may reverse the former action and itself enter judgment n.o.v. • • •."

See also the quotation from the case of *Baltimore & Carolina* v. *Redman* appearing on pages 18-19 hereof.

We have pointed out hereinabove that in this case the Court concluded that the evidence viewed in the aspect most favorable to plaintiff does not sustain the conclusion that the Johnson patent is valid. As stated by this Court in *Coughran* v. *Bigelow* (164 U. S. 301, 308):

> "• • • granting a nonsuit for want of sufficient evidence is not an infringement of the constitutional right of trial by jury."

In *Capital Traction Co.* v. *Hof* (174 U. S. 1, 13), this Court stated:

> "'Trial by jury' in the primary and usual sense of the term at the common law and in the American Constitutions, is not merely a trial by a jury of twelve men before an officer vested with authority to cause them to be summoned and impaneled, to administer oaths to them and to the constable in charge, and to enter judgment and issue execution on their verdict; but it is a trial by a jury of twelve men, in the presence and under the superintendence of a judge empowered to instruct them on the law and to advise them on the facts, and (except on acquittal of a criminal charge) to set aside their verdict if in his opinion it is against the law or the evidence. This proposition has been so generally admitted, and so seldom contested, that there has been little occasion for its distinct assertion. Yet there are unequivocal statements of it to be found in the books."

Under these authorities, the Johnson patent being clearly invalid for lack of patentable invention, and "the evidence" establishing that the Johnsons' contribution to the art of lubrication did not rise to the level of patentable invention, the trial court should have directed the jury to return a verdict for the defendant upon its motion or, in the alternative, should have granted its motion for judgment notwithstand-

ing the verdict. It was this error of the trial court which the Court of Appeals corrected by reversing the judgment of the lower Court. This exercise of familiar judicial power by the Court of Appeals did not in any way infringe upon Petitioner's rights to a jury trial guaranteed to it by the Seventh Amendment.

In essence the Court below held that patentable invention was not involved when the old type manually operated coupler was equipped with the multi-jawed chucks of the prior art, and that this was particularly true when such a combination had theretofore been disclosed and published in the Butler and other patents.* The Court held that such a structure was clearly invalid for lack of patentable invention and properly reversed the judgment entered by the trial court. In so reversing the judgment of the trial court the Court of Appeals did not weigh conflicting evidence, it did not consider the credibility of witnesses, and it did not make any findings of fact on fact questions which were in any way disputed. The Court of Appeals in its opinion merely accepted uncontroverted facts which led only to the conclusion that the Johnson patent is invalid for lack of invention (*Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560.

This Case Does Not Involve the Question Whether Invention Is a Question of Law or Fact.

Petitioner asserts that a question involved in this case is the determination of whether invention is a question of fact or a question of law (Question 1, Petition page 31). There is no occasion for this Court to consider this question in this case because there is no such question present. The

* See chart attached at rear of this brief.

Court of Appeals in its opinion held that as a matter of law the Johnson patent is invalid. The Court stated:

> "The vital question for decision is, we think, whether the patent in suit (referred to as the Johnson patent) is clearly invalid for lack of patentable invention over the prior art. If the patent is clearly void, the verdict of the jury is, of course, of no help to the plaintiff and other questions need not be considered." (176 F. 2d 445; VIII R. 2238.)

The Court also said in its opinion:

> "* * * the evidence," (*i. e.*, the facts) "viewed in the aspect most favorable to the plaintiff, does not sustain the conclusion that the Johnsons' contribution to the art of lubrication rose to the level of patentable invention * * *." (176 F. 2d 449; VIII R. 2245.)

It is therefore clear that if invention be a question of law the Court of Appeals as a matter of law has held in this case that there is no invention in the patent in suit and that if invention be a question of fact the Court of Appeals has held that on the uncontroverted facts Johnsons' contribution to the art of lubrication did not rise to the level of patentable invention. Regardless, therefore, of whether invention is a question of fact or law, the conclusion is the same, *i. e.*, that the Johnson patent is invalid.

III.

THE OPINION OF THE COURT OF APPEALS BELOW DID NOT MISINTERPRET OR UNDULY EXPAND THE OPINIONS OF THIS COURT IN BASSICK v. HOLLINGSHEAD, ROGERS v. ALEMITE, AND LINCOLN v. STEWART-WARNER.

Petitioner by its question 10 (Petition page 36) suggests that the opinion of the Court of Appeals in this case misinterprets and unduly expands the opinions of this Court in *Bassick* v. *Hollingshead, Rogers* v. *Alemite* (298 U. S.

415) and *Lincoln* v. *Stewart-Warner* (303 U. S. 545). There is no basis for this assertion. In its opinion the Court of Appeals properly interpreted the cited opinions of this Court when it stated (176 R. 2d 444, 446; VIII R. 2240):

> "* * * The question of contributory infringement reached the Supreme Court in 1935 and was decided on May 18, 1936, in the cases of *Bassick Manufacturing Co.* v. *R. M. Hollingshead Co.*, and *Rogers et al.* v. *Alemite Corporation*, 298 U. S. 415. The Supreme Court held, in substance, that, since the combination of a grease pump, connecting conduit, coupler, and pin fitting was old in the art, Gullborg could not, by inventing a new and improved type of coupler or pin fitting, claim either of these in combination with the old forms of the other elements so as to exclude the public from the use and sale of the old forms of fittings or grease guns even though these might be used respectively with Gullborg's improved coupler or his improved pin fittings, because, in the combinations claimed, an old-type fitting or an old-type coupler had no novel function over those of the prior art. See *Lincoln Engineering Co.* v. *Stewart-Warner Corporation* (1938, 303 U. S. 545, 547-548)."

From this quotation from the opinion of the Court below it is apparent that the Court was aware of the precise limitations expressed in these opinions of this Court. Nowhere in the opinion of the Court below is there a statement that the Johnson patent is invalid because its claims include a grease gun or fitting. Nowhere is there in the opinion of the Court below any statement that the claims of the Johnson patent are invalid because they claimed more than the patentee invented as this Court held in the *Hollingshead, Rogers,* and *Lincoln* cases. In its opinion the Court of Appeals stated:

> "* * * What the Johnsons did—as we see it—was to substitute for the bayonet type of connecting means

of Gullborg, which was old, a chuck type of connecting means, also old. * * * Substituting an old and well known form of coupler for another form of coupler equally well known, did not, in our opinion, require invention, but merely mechanical skill. * * *

"* * * To use means old in the art to clamp a grease nozzle to a grease fitting so as to form a tight connection, does not involve patentable invention. * * *"
(176 F. 2d 448; VIII R. 2244, 2245.)

Here are clear and unequivocal statements by the Court of Appeals that the specific coupler construction disclosed and claimed in the Johnson patent does not in and of itself constitute a patentable invention. There is, therefore, no basis for the contention that the opinion of the Court below misinterpreted or unduly expanded the earlier opinions of this Court.

IV.

IN URGING THAT THE DECISION OF THE COURT OF APPEALS IN STEWART-WARNER v. JIFFY (81 F. 2d 786) WAS CONTRADICTED BY THE INSTANT DECISION PETITIONER MISSTATES THE EARLIER DECISION.

Petitioner repeatedly (Petition pp. 4-8, 17-18, 23, 25, 26, 32, 42; Brief, pp. 7-10, 11-12, 26, 29) asserts that when the Eighth Circuit Court of Appeals held the Johnson patent clearly invalid it failed to follow its own earlier determination of the presence of invention in the Johnson ("Jiffy") coupler in *Stewart-Warner Corp.* v. *Jiffy Lubricator Co.*, 81 F. 2d 786.

This repeated misrepresentation that there was a common issue decided differently in the two cases is not only completely refuted by the Record, but was denied by the Court of Appeals when it answered Petitioner's contention that the earlier opinion found invention in the "Jiffy" coupler:

"While this Court distinguished the Jiffy hydraulic

> coupler, the accused device in that case, from the device of Butler, and was of the view that the Alemite hydraulic coupler, made by the Stewart-Warner Corporation, did not conform to the Butler patent, the Court did not hold that whatever advance in the art over the Butler coupler was disclosed by the Jiffy hydraulic coupler would amount to patentable invention." (176 F. 2d 447.)

Petitioner was not unaware of this flat answer to the argument about which the Petition is built, as Petitioner quotes in its Brief a mutilated fragment of this passage, as well as another mutilated excerpt from the opinion also distinguishing the earlier decision (Brief, p. 29). Although the opinion of the Court of Appeals contains an adequate answer to this repeated perversion of the relationship of the two cases, the essential facts of the cases preclude any such construction as Petitioner seeks to force upon them.

The opinion of the Court of Appeals in *Stewart-Warner Corp.* v. *Jiffy Lubricator Company* (81 F. 2d 786), involving the scope of the Butler patent was announced February 11, 1936. The Johnson patent involved in the instant suit did not issue until May 12, 1936. Neither the application on which the Johnson patent issued nor any of the claims which issued in the Johnson patent were before the Court of Appeals in the earlier case. It is therefore manifest that the Court of Appeals in this earlier decision did not and could not have considered the validity of the Johnson patent, the only question determined by the Court below.

In deciding the case of *Stewart-Warner* v. *Jiffy,* the Court of Appeals was concerned with the validity and scope of the claims of Butler patent No. 1,593,791 which issued in 1926 (V R. 1706), *i. e.,* ten years prior to the issuance of the Johnson patent. The Court of Appeals for the Eighth Circuit in *Stewart-Warner* v. *Jiffy* (81 F.

2d 786), held that such a coupler lacked invention over the prior art and that Butler's claims had to be limited to a specific form of chuck construction. Later the Court of Appeals for the Seventh Circuit in *Lincoln* v. *Stewart-Warner* (91 F. 2d 757), gave Butler's monopoly a broader construction. This Court subsequently held the Butler patent invalid, but also held that Butler's contribution could not have been more than a hydraulic coupler in which the lubricant pressure forced the chuck jaws over the nipple, the same chuck which the Johnson patent seeks to cover. The difference between the two Courts of Appeals with respect to the scope of Butler's monopoly is of no importance in the present controversy since under either construction neither the Johnsons nor others are entitled to re-patent what Butler had earlier disclosed and sought to claim as his monopoly.

From the foregoing it will be apparent that in *Stewart-Warner* v. *Jiffy* the Court of Appeals was concerned only with the question of validity and infringement of the claims of the Butler patent. In the present litigation the issues are the validity and infringement of the claims of the Johnson patent. This difference in issues alone clearly repudiates Petitioner's repeated misrepresentation that the instant decision reverses or contradicts findings made in the earlier case.

This is only one of several instances in which petitioner throughout this litigation has sought to misconstrue and misapply the decision of the Court of Appeals in *Stewart-Warner* v. *Jiffy*.

Conclusion.

The opinion and judgment of the Court below predicated upon the clear invalidity of the Johnson patent must stand because the chuck coupler of the Johnson patent does not constitute a patentable invention over the prior art.

Nowhere in the Petition or in the Brief filed in support thereof does Petitioner point out any distinguishing characteristic, either in the structure or mode of operation of the Johnson coupler, which would lift it over the prior art. Petitioner offers no suggestion as to what Johnson accomplished by his alleged invention which was not accomplished equally well by the same combination of old elements operating in the same way in the prior art.

In the welter and maze of nonrelevant facts and immaterial arguments and fancied questions asserted, Petitioner has refused to meet the basic issue determined by the Court below that there is no patentable invention in the Johnson patent. The Court below correctly held that the Johnson patent is clearly invalid.

The Petition for a writ of certiorari should be denied.

Respectfully submitted,

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February 14, 1950.